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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 07/728,428 | 07/11/1991 | JO ANN M. CANICH | 89B010-D-1 | 5216 |

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| EXAMINER | |
|---|---|
| RABAGO, ROBERTO | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1713 | 23 |

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 07/728,428 | CANICH, JO ANN M. | |
| | Examiner | Art Unit | |
| | Roberto Rábago | 1713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *4,5,27,29,35-41,44 and 45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *5,27 and 41* is/are allowed.

6)☒ Claim(s) *4,29,35-40,44 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This application was involved in Interference No. 102,953, which has terminated with decision in favor of the instant applicant.

2. Prosecution in this application is reopened in view of a new ground of rejection as set forth below. Accordingly, amendments filed during interference proceedings are entered.

2. The Board of Patent Appeals and Interferences rendered a Final Decision in interference No. 102,953 on 12/29/2000, which determined that applicant is entitled to a patent including the claims designated as corresponding to the count. However, the decision in related Interference No. 103,819, wherein the instant applicant was junior party, bears on the patentability of the instant claims because the count of the '819 interference was directed to catalysts comprising metallocenes within the scope of the claims of this application. Following a request for entry of adverse judgment under 37 CFR 1.662 filed by the junior party, judgment was rendered in Interference No. 103,819 against the instant applicant. 37 CFR 1.662 reads in part:

> (a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. The filing by a party of a written disclaimer of the invention defined by a count, concession of priority or unpatentability of the subject matter of a count, abandonment of the invention defined by a count, or abandonment of the contest as to a count will be treated as a request for entry of an adverse judgment against the applicant or patentee as to all claims which correspond to the count.

The decision in Interference No. 102,953 made brief mention of the existence of Interference No. 103,819 (see Final Decision, "Other Issues" section III) but makes no specific comment on the significance of the conclusion that the opposing party was awarded priority to a genus of catalyst comprising a bridged titanium complex which is squarely within the scope of numerous claims of the instant application.

Accordingly, the following rejection is based upon the premise that the senior party in Interference No. 103,819 is the prior inventor of the subject matter covered by the count of Interference No. 103,819, directed to a catalyst comprising a genus of bridged titanocene and alumoxane, and therefore the instant applicant is not entitled to a scope of claims in this application which includes subject matter which has been lost in Interference No. 103,819.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

4. Claims 4, 35-40, 44 and 45 are rejected under 35 U.S.C. 102(g) in view of the lost count in Interference No. 103,819. Copies of the count and judgment in

Interference No. 103,819 were mailed to applicant on 1/26/1998 and 11/19/1998, respectively, and are therefore not provided again herewith.

The count of Interference No. 103,819 sets forth a catalyst for addition polymerization including a titanocene having a bidentate ligand comprising one Cp group and a group V heteroatom bridged via a group IV or V element, the catalyst further comprising alumoxane. The catalyst set forth in the count clearly anticipates the instant claims.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,617,466. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although worded slightly differently, the instant claim recites

essentially the same process of making a metallocene complex as that already patented.

***Specification***

7. Tables 1 and 2 are objected to because they are substantially illegible due to numerous photocopying generations. Although the tables are sufficient for examination, substantial printing errors would likely result should this application mature into a patent. New tables should include the change made in the amendment to the specification filed October 22, 1992.

***Allowable Subject Matter***

8. Claims 5, 27 and 41 are allowed. Neither the references cited on this record nor the lost interference count disclose or reasonably suggest the transition metal complex which does not include titanium (claims 5 and 41) or is unbridged and includes a component L (claim 27).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ROBERTO RABAGO
PATENT EXAMINER

Art Unit 1713

RR
March 23, 2004